

App. Serial No. 09/932,085
Docket No. NL 000460
Office Action Response and Amendment

Remarks

Claims 1-9 are pending in the application. Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated June 4, 2003, raised objections regarding specified text of the Specification and Abstract, the designation of Figures 1 and 2, recitation of terminology in the figures (Fig. 1 and 3); and claim 5 is objected to for an informality. Also, claims 1-5 stand rejected under 35 U.S.C. § 103(a) over *Weber et al.* (U.S. Patent No. 4,866,349) in view of *Lo* (U.S. Patent No. 6,483,490).

Regarding the objections to the Specification and Abstract, Applicant has presented the suggested minor amendments, and believes that the objections are now overcome.

Regarding the objections to Figures 1 and 2, Applicant has provided two replacement sheets for these figures as recommended in the Office Action (*i.e.*, now denoted as "Prior Art").

Regarding the general objection to the figures under 37 C.F.R. § 1.83(a), Applicant respectfully traverses because at least Fig. 3 already shows these features, (Vc) and (CL). Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings. Should an objection remain, Applicant respectfully requests clarification.

The claims are amended for non-statutory reasons: to correct one or more typographical errors or the health of the informalities, remove figure label numbers, and to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in scope and no new matter is added.

The Office Action objects to claim 5 for a typographical error. The error is collected in the aforementioned amendments to the claims. Accordingly, Applicant requests that the objection be removed.

With regard to the rejection of claims 1-5 under 35 U.S.C. § 103(a) over U.S. Patent No. 4,866,349 to *Weber et al.* in view of U.S. Patent No. 6,483,490 to *Lo*, Applicant respectfully traverses. To establish a *prima facie* case for rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art and any asserted combination of prior art teachings must be motivated. MPEP §§ 2143.01 and

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2143.03. Applicant submits that this rejection is flawed because the claimed invention is not taught or suggested by the combined teachings of the prior art and because the proposed combination of teachings is not motivated.

As characterized by the Office Action, the combined teachings of the prior art fail to correspond to the claimed invention at least with respect to the claim limitations directed to the "loop being closed not later than an instant at which said current changes polarity at the end of the resonance period." The Office Action appears to ignore these limitations in rejecting claim 1 and does not attempt to allege specific correspondence between the *Weber* '349 reference and this aspect of the claimed invention. Moreover, Applicant fails to recognize where either the *Weber* '349 reference or the *Lo* '490 reference would provide any such teaching. Since neither reference by itself appears to teach this aspect of the claimed invention, these references as combined would not teach this aspect of the claimed invention.

In addition, the Office Action presents an erroneous interpretation of the teachings of the '490 reference by alleging that the '490 switch circuit (Figure 7) would present a circulating current through the inductor. The '490 switch circuit is coupled to the inductor by a capacitor (C2) which would inherently block current from looping around the inductor (L2) of the '490 switch circuit. With regard to one or both aspects of this cited prior art, the Office Action has failed to present a *prima facie* case under Section 103(a). Without a showing of complete correspondence between the recited limitations of the claim(s) and the teachings of the cited references, a Section 103(a) rejection cannot be maintained and Applicant accordingly requests that the rejection be withdrawn.

The Section 103 rejection is also deficient in that there is no evidence in support of the proposed combination of teachings. As for the Office Action's alleged motivation to modify the '349 reference, this alleged motivation is improper because, among other issues, the proposed combination would frustrate the purpose and operation of the '349 reference. As pointed out in MPEP § 2143.01, if a proposed modification would render the prior art teachings being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification under 35 U.S.C. § 103(a). The proposed modification would insert the '490 switch circuit (Figure 7) into the loop circuit of Figure 5 of the '349 reference and then have the '490 switch circuit

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controlled in a manner as motivated by the teachings of the '490 switch circuit. Depending on the particular implementation (e.g., with or without the capacitor (C2) included with the added switch circuit), such a unique circuit design would appear to be highly undesirable. With the capacitor (C2), current would not flow through to the inductor. Without the capacitor (C2), there would be no connection. In either case, there is no loop current. Moreover, with the capacitor (C2), a likely result (depending on the parasitics) would be a significantly increased and intolerable modulation in the energy level in and around the inductor thereby leading to an inoperable driver and failing to serve the purposes of the '490 reference. Since the proposed modification would render the prior art teachings unsatisfactory for its intended purpose, the rejection should be withdrawn for this reason as well.

The newly-presented claims include at least the limitations of claim 1 and therefore, are believed to be distinguishable from the cited prior art for the same reasons presented above with the traversal of the rejection of claim 1.

In view of the remarks above, Applicant believes that the rejection has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney overseeing the application file, Mr. Eric M. Bram, of Philips Corporation at (914) 333-9635.

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Attached: Two Replacement Drawing Sheets

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